

Appl. No. 10/656,021
Amdt. dated September 10, 2004
Reply to Office action of August 12, 2004

REMARKS/ARGUMENTS

I. RESTRICTION REQUIREMENT

Applicant received the Restriction Requirement of August 12, 2004, in which the Examiner restricted the claims into four groups. Merely to expedite prosecution, Applicant elects, with traverse, Group 1 (claims 1-5), withdraw claims 6-16, and may file a divisional application for the withdrawn claims.

With respect to claims 17-19, Applicant asserts that claims 17-19 should be examined with claims 1-5. The Examiner asserts that claims 17-19 should be classified and examined in class 396, subclass 225+ (PHOTOGRAPHY/EXPOSURE CONTROL CIRCUIT/COLOR TEMPERATURE COMPENSATION OR DETECTION) rather than class 430 (RADIATION IMAGERY CHEMISTRY: PROCESS, COMPOSITION, OR PRODUCT THEREOF). Applicant respectfully disagrees.

The elements of claims 17-19 are written in § 112, para. 6 "means plus function" form. Thus, when examining the claims, the Examiner must construe the claims to cover "the corresponding structure [and] material . . . described in the specification and equivalents thereof." 35 U.S.C. § 112, para. 6. Although, during examination, Examiners are to give claim terms their broadest reasonable construction, that includes adhering to the mandate of 35 U.S.C. § 112, para. 6 that means plus function terms be interpreted to cover the structures disclosed in the specification and their equivalents, not every conceivable means for performing the named function. *In re Donaldson*, 16 F.3d 1189, 1194, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994) (*en banc*). In *Donaldson*, the Board interpreted a "means-plus-function" claim term as broadly as possible (*i.e.*, to encompass every means for performing the recited function) rather than evaluating the claim term to cover the means disclosed in the specification (as required by § 112, ¶ 6). Based upon that interpretation, the Board found the claim at issue obvious in light of the prior art. The Federal Circuit reversed, stating, "the 'broadest reasonable interpretation' that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112] paragraph six." *Id.*

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Thus, when reading claims 17-19 in light of the structures and materials disclosed in the specification, it becomes clear that claims 17-19 are analogous to (although not necessarily identical to)¹ claims 1-5. For example, claim 2 and claim 17, when their chemical components are compared side-by-side, contain analogous elements:

CLAIM 2	CLAIM 17
"an antenna" (incorporated from independent claim 1)	"means for absorbing energy"
"a color former"	"means for forming color"
"an activator"	"means for initiating a color change"
"a matrix" (incorporated from independent claim 1)	"means for binding the absorbing means"

Therefore, Applicant respectfully asserts that claims 17-19 are within the same classification as claims 1-5. Thus, no extra searching will be required and claims 17-19 should be examined along with claims 1-5.

II. ELECTION OF SPECIES

The Examiner has stated that claims 1-19 are generic to a plurality of patentably distinct species. With respect to the various chemical ingredients recited in the claims, Applicant elects as follows:

matrix – ultraviolet curable acrylates

antenna – silicon 2,3 naphthalocyanine bis(trihexylsilyloxy)

color former – 2'-anilino-3' methyl-6'-(dibutylamino) fluoran

activator – bisphenol A

This election is not an admission by the Applicant that the recited chemical ingredients of the claims are limited to the elected species, but merely an election of species as required by the Examiner. Applicant asserts that all of claims 1-5 and 17-19 are generic to this species.

¹ By stating that claims 1-5 and 17-19 are analogous, Applicant does not intend to indicate that any of claims 1-5 or their individual elements are necessarily coextensive with any of claims 17-19 or their elements or vice versa. However, by evaluating claims 17-19 in light of § 112, para. 6, it is clear that claims 1-5 and 17-19 are within the same art unit and should be examined together.

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Further, the Examiner requires that the Applicant "[identify] the elected chemical structure antenna is either (1) infrared radiation or (2) laser radiation absorption." Applicant assumes that the Examiner wants to know whether the elected species absorbs infrared radiation or laser radiation. Applicant submits that laser radiation and infrared radiation are not mutually exclusive. The elected antenna (silicon 2,3 naphthalocyanine bis(trihexylsilyloxy)) absorbs infrared radiation whether from a laser or otherwise.

III. CONCLUSION

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Hewlett-Packard Company Deposit Account Number 08-2025 and enter any time extension(s) necessary to prevent this case from being abandoned.

Respectfully submitted,



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